

Application Number: 09/396,531

Group Art Unit: 3711

Filing Date: 9/15/99

Examiner Name: William Pierce

Inventors: Randall Addington et al.

Attorney Docket No.: 99-1001

Title: Bowlers Aid

Assistant Commissioner of Patents  
Washington, D.C. 20231

Before The Board Of Appeals And Interferences

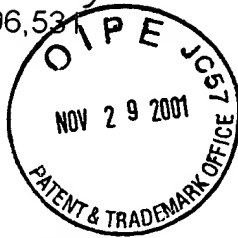
Appellants' Reply To Examiner's Answer

Summary

Examiner has not complied with the standard for Patent Office examination, as set forth below as the APA Standard of substantial evidence. Examiner's incomplete record forces a Appellants and the Board to rely on Examiner's understanding or on what Examiner believes to be common sense, without a fact based record in support of his critical conclusions.

An example of the deficient examination and incomplete record in this case is seen in the rejection of claims 16-21, 27-32, as anticipated by Mariense under 102(b). In that rejection, Examiner's record based facts in support of his

- a) knowledge of one of ordinary skill in the art,
- b) understanding of the specification and claims by one of ordinary skill in bowling,
- c) the location in the prior art where Examiner sees the recited claim elements,
- d) the reasoning used by Examiner to apply the prior art teachings to the recited claim elements as interpreted by Examiner, and,
- e) the record supported facts and reasoning applied by Examiner to all of the issues



RECEIVED  
DEC 03 2001  
TECHNOLOGY CENTER R3700

#19  
12/6/01  
R1604d

e) the record supported facts and reasoning applied by Examiner to all of the issues raised by Appellants.

By failing to meet the examination standard of substantial evidence, Examiner has left a deficient record and Appellants and the Board are left to guess at the facts or reasons of the critical determinations made by the Examiner. The case law cited by Examiner is based on facts which are not the facts of Appellant's recited invention and are inapplicable.

Appellants cannot receive a fair hearing based on Examiner's incomplete record and rejection of Appellants' claims should be reversed or, in the alternative, this application should be sent back to the Examiner for a full examination under the examination standard of substantial evidence, with the term of any patent issuing from this application extended from the date of Examiner's first Office Action.

I.

The Standard Of Appellate Review For Patent Office Examination, Requires Examiner's Findings Be Supported By Substantial Evidence In the Record

Board review of Examiner's rejection is made under the standard of substantial evidence, as set forth below. Appellants' Brief contends Examiner's finding of fact are unsupported by substantial evidence in the record and fails to meet the examination standard of substantial evidence. Examiner's grounds for rejection must be reversed when factual findings underlying Examiner's stated grounds of rejection are not supported by concrete evidence in the record. *In re. Zurko* 258 F.3d 1379 (Fed. Cir) 2001, at 1386. The substantial evidence standard of review for a Patent Office rejection requires complete record of all of the facts and reasoning that were used or should have been used, in support of the arguments rejecting Appellants' claims and rebutting Appellants' arguments for patentability.

The substantial evidence standard requires a finding of such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.

*id*, at 1384.

Basic knowledge or common sense, which is not based on any evidence in the record, lacks substantial evidence support.

*id. at 1385.*

Patent Office expertise is restricted to the support of conclusions “as to peripheral issues,”  
However,

With respect to core factual findings in a determination of patentability ... the [Examiner] cannot simply reach conclusions based on its own understanding or experience -or on [Examiner’s] assessment of what would be basic knowledge or common sense. Rather, the [Examiner] must point to some concrete evidence in the record in support of.. [Examiner’s] findings.

*Id at 1385, 1386.*

Required in support of a rejection is concrete evidence in the record. *In re. Zurko 258 F.3d 1379 (Fed. Cir) 2001, at 1386.*

This standard for all Patent Office examination review is hereinafter referred to as the “APA Standard”.

## II.

Reply To Examiner’s Answer, that “Appellants remarks with respect to the Administrative Procedure Act are inappropriate,” as made by Examiner in (11) Response to Argument,  
pages 4 - 6

Examiner demonstrates by his statement,

...in the future the CAFC will be unable to substitute its judgment for that of the USPTO unless the CAFC determines the USPTO abused its discretion or acted arbitrarily or capriciously in reaching its conclusion of unpatentability,

that he examined Appellants’ claims under the rejected examination standard of abuse of

discretion or under the standard of acting arbitrary or capricious. The correct examination standard is the Administrative Procedure Act standard of substantial evidence, as set forth in *Zurko*, wherein the arbitrary or capricious standard, used by Examiner, was rejected by the CAFC. *Zurko*, 1381.

Accordingly, unless Examiner's grounds for rejecting Appellants' claims meet the CAFC examination review standard of substantial evidence, Examiner's grounds for rejection of Appellants' claims are defective or deficient as based on the CAFC rejected standard of review of arbitrary or capricious.

Appellants incorporate in all of their Replies to Examiner's Answer, as stated below, the examination review APA Standard of substantial evidence, as stated above, and asks The Board to reverse Examiner's Answers where Examiner's findings or conclusions are not supported by substantial evidence, meaning concrete evidence in the record, or where Examiner has failed to address all of Appellants' issues in the record.

### III.

Reply To Examiner's *Summary of Invention*, as stated in Examiner's Answer, (5) (no page number given)

Examiner's *Summary of Invention* is,

- a) incorrect,
- b) is unsupported by facts in the record,
- c) fails the APA Standard of substantial evidence,
- d) shows Examiner does not have the ordinary skill in the art of bowling,
- e) shows Examiner does not know how to bowl or how one of ordinary skill in the art of bowling would bowl, and
- d) Examiner's *Summary* should be stricken

A.

Examiner's *Summary of the Invention* is incorrect and not supported by the facts in Appellants' specification.

Examiner has failed to identify what one of ordinary skill in the art of bowling would understand or know about bowling. Examiner, while identifying himself as one of skill in the art, fails to show by record facts what he knows about bowling, by way of his personal experience or knowledge or by referral to the prior art, or otherwise why anyone should be expected to accept his statement that he is one of ordinary skill in the art of bowling.

Even if Examiner is accepted as one of ordinary skill in the art of bowling, Examiner has failed to show any facts in support of his conclusions.

Examiner has shown no references to any facts of the invention in Appellants' specification as incorrect or in support of Examiner's *Summary of the Invention*. Examiner has merely stated his conclusions based on his own understanding or experience, or on examiner's assessment of what would be basic knowledge or common sense. Examiner's conclusion, as stated in the *Summary*, is that the invention is a finger cot. While Examiner's statement "the invention is a finger protector intended to be used when a person bowls," is correct, Examiner has failed to show any fact within the record in support of this statement as the exclusive or limited definition of Appellants' invention or that this statement or the *Summary* as relevant to Appellants' invention as claimed, as described in the specification, or as recited in the claims and as would be understood by one of ordinary skill in the art. Examiner's *Summary*, lacking record supported facts and failing to address the description of the invention and the recited claims or apply the understanding of one of ordinary skill in the art to the specification and claims, fails to meet the APA Standard of substantial evidence.

B.

Examiner does not have the knowledge of one of ordinary skill in the art of bowling, does not know how one of ordinary skill in bowling would bowl and in not one of ordinary skill in the art of bowling

The understanding of one skilled in the art of how a bowling ball is released and lift is applied to place spin on the ball is as shown in the cited Shaffer Patent 4,371,163 (hereafter "the Shaffer patent"), col. 3, lines 34 - 62 and col. 4, lines 1- 25, and as described by R.A. Addington in his Declaration. The cited Shaffer patent and the R.A. Addington Declaration are made of record in this Application and in this Appeal. See Appellants' Brief, Section III.(Argument No. 3), B. As for example described in the cited Shaffer patent, in order to spin the ball in an effect known as lift, first the bowler's thumb must come out of the ball and then the middle two fingers rotate the underside of the ball upward as they leave the ball upon release. The cited Shaffer patent, col. 3, lines 45 -55.

In his *Summary*,

1) Examiner states the invention is a finger cot designed to be worn over the finger for protection and grip while a person is bowling.

2) Examiner states when a bowler throws a bowling ball, the ball is swung forward with the thumb at a " (sic) 12 o'clock position (for a right hand bowler).

3) Examiner states a) during the upswing the thumb has a natural tendency to rotate to about the 9 o'clock position while placing rotation on the ball, b) When this tendency to rotate is further increased by a bowler, this is referred to as "lift" on the ball, and 3) This style of bowling is done in order to place spin on the ball...

4) Examiner states where grip is important, bowlers have been known to wear finger cots to improve the grip...

Contrary to Examiner's statements that the invention is a "finger cot," used to "grip the ball, and worn "to improve the grip," the facts in the record show the contrary, that the invention is described and claimed, for example in claim 16, as "a means for protecting a bowler's finger pad," and recited in the claims in functional language for a) placement in a contact area over

the finger pad of a bowler, b) receiving the force of the bowling ball when the bowler's maximum force is applied to lift the ball in releasing the bowling and c) spreading the force of the bowling ball over the contact area made with the bowler's finger pad.

Examiner's *Summary*, describing the invention, as shown above, as used in gripping the ball or using a finger protector to improve the grip or using the thumb to spin or lift the ball, is inconsistent with and contrary to, the knowledge of one of ordinary skill in the art of bowling of how a bowling ball is released from the middle two finger to spin or impart lift to the ball upon release of the bowling ball, and is contrary to the record facts.

The description of the invention and claims are written for person of ordinary skill in the art, as shown by the record facts. see MPEP 2171. As shown by the cited Shaffer patent and by the Declaration of R.A. Addington, one of ordinary skill in the art would understand the invention as claimed, in relation to the application of lift to the lift to the ball, upon its release from the middle fingers.

Examiner's *Summary*, however as demonstrated by the above statements describing Appellants' invention, shows Examiner doesn't have the understanding of one of ordinary skill in the art of how a bowling ball is released with lift imparted from the middle fingers. See the cited Shaffer patent col. 3, lines 46 - 56, explaining how the middle fingers are used to apply lift on release of the ball and after the bowler's thumb first comes out of the ball. See Also Declaration of R.A. Addington and Appellants Brief, Section III., B. To put it in a different, way, Examiner when describing how to bowl, would instruct the bowler to use the thumb, as stated by Examiner in Examiner's *Summary*, above, so

when a bowler throws a bowling ball, the ball is swung forward with the thumb at a 12 o'clock position (for a right hand bowler); and, during the upswing the thumb has a natural tendency to rotate to about the 9 o'clock position while placing rotation on the ball. When this tendency to rotate is further increased by a bowler, this is referred to as "lift" on the ball. This style of bowling is done in order to place spin on the ball.

This Examiner summarized method of bowling is not supported by record facts, and is not the correct method used by one of ordinary skill in the art of bowling; as shown in the cited Shaffer patent and in the Declaration of R.A. Addington.

In brief, Examiner does not know how to bowl as would one of ordinary skill in the art of bowling. Examiner's description of bowling given in his *Summary*, is without any record based fact support. Marine, which is the only bowling related patent cited by Examiner, has no facts related to imparting lift to the ball at its release or using the middle two fingers to release the ball with lift. Marine is limited to a thumb protector, used to grip the ball, without any disclosure of how the thumb may be used in "throwing a hook." See Marine, col1, lines 13-19.

Examiner is not one of ordinary skill in the art, as demonstrated by the record facts and any presumption that may have existed or which Examiner could claim, has been removed.

Any description by Examiner's of how to apply lift to the ball on its release, as disclosed and claimed by Appellants, is based on Examiner's own understanding or experience or on Examiner's assessment of what would be basic knowledge or common sense. That is an impermissible support for Examiner's rejection. Rather, the APA Standard requires Examiner must point to some concrete evidence in the record in support of.. Examiner's findings, which Examiner has failed to accomplish and had failed to make a complete record as required by the APA Standard.

C.

Examiner's *Summary* should be stricken

Examiner's *Summary* is prejudicial, without support by substantial evidence and The Board should strike it from the record of this application.



IV.

Reply to Examiner's Answer, Section VIII; 1.(Argument No. 1, "A and "B", " Pages 6-9

Appellant stands on his statement made in Appellants' Brief, VIII., 1.(Argument No. 1, "A" and "B") and adds the following statements in reply.

1.

Examiner's argument is limited to conclusions which are unsupported by facts in the record

Examiner has the burden of examining each claim, element by element, and explaining why, if at all, there is any ambiguity. MPEP 2181. APA Standard of Substantial Evidence.

All that Examiner has stated is limited to his conclusions Appellants' claims are not clear to Examiner because Examiner cannot determine if the bowler or the bowling ball are being claimed in the combination with the recited elements of the claimed bowling device. With regard to the recitations of claims 1-32, Examiner has said,

a) While the ball is functionally recited in the preamble, it is positively recited in the body of the claim. The preamble and the body of the claim must be in harmony.

b) . . . the claim positively recites the "bowler" and "said bowler's finger" implying that such is also being claimed in combination which is improper.  
(underlining added)

c) With out the combination of the bowling ball one could not determine any metes or bounds to the claims since one could not be 'receiving a force of said bowling ball.'

d) It appears that applicant is limiting the field of use to the combination of a bowling ball since the shield and its structure is being recited as dependent upon forces imposed by the bowling ball.

e) . . . the specification does not set forth any standard to which one can measure the scope of the claim and one skilled in the art could not know the scope of the claim.

f) the examiner, being one skilled in the art

g) . . . the specification does not set forth any standard to which one can measure the scope of the claim and one skilled in the art could not know the scope of the claim.

Examiner has failed to state the record based facts in support of his above statements or of Examiner's interpretation of the claims. Examiner has not stated any record based facts relevant to what one of ordinary skill in the art of bowling would know, or why or how Examiner believes he is one of ordinary skill in the art, or how one of ordinary skill in the art of bowling would bowl or why or how one of ordinary skill in the art of bowling would interpret the claims, and which are consistent with Examiner's above statements or why or how, as Examiner states that he,

being one skilled in the art [he does not have a clue what [a maximum natural force limited by a limit of muscular skeletal development] means,

while at the same time, Examiner has offered his own interpretation of the claims which Examiner has used as a grounds of rejection.

Examiner's has ignored or failed to answer Appellants' arguments and issues with record based facts, leaving the record incomplete, while denying Appellants their right to an examination on the merits, and to notice of the reasons for the rejection of Appellants' claims. This failure of Examiner is not permitted under APA Standard of substantial evidence or 35 USC 132.. Examiner has failed to interpret the claims using the record based facts of the claims or the specification, as one with ordinary skill in the art. See Section III., above.

Appellants have established the level of one of ordinary skill in the art by Appellants' reference to the cited Shaffer patent, and the Declaration of R.A. Addington, showing what one of ordinary skill in the art of bowling would know about bowling and how one of ordinary skill in the art would bowl. As shown by Appellants, in the specification, the claims, in the Declaration of R.A. Addington and by the Shaffer patent, (see Section III.), and in the Mariense patent, applied by Examiner as prior art and in Examiner's own grounds of rejection explaining how the thumb protector of Marinense would be used by the bowler to protect the thumb from the force of the bowling ball. any one with ordinary skill in the art of bowling would know a bowling device or bowling apparatus is used by a bowler in bowling a ball and not as part of a claimed combination of the bowling device and the bowler and the

ball. To assert as a combination, the bowling device, combined with the bowler who is releasing the ball, and the ball, as operating parts of a recited machine is illogical and ridiculous, in view of the record based facts and Examiner's own statements. .

Examiner has not rebutted Appellants' showing of the ordinary skill in the art of bowling or has Examiner made any record based facts showing of what Examiner believes is the level of ordinary skill in the art, or, or based on the knowledge of one of ordinary skill in the art, how the claims should be interpreted. Examiner has stated conclusions, without record supported fact, that the claims are ambiguous or indefinite. For example, in paragraph b) above, Examiner states, " . . . the claim positively recites the "bowler" and "said bowler's finger" implying that such is also being claimed in combination which is improper," but without providing any record based fact or reasons with regard to the knowledge of one of ordinary skill in the art, why Examiner believes that implication is a rational conclusion.

In paragraph d, above, Examiner states, " It appears that applicant is limiting the field of use to the combination of a bowling ball since the shield and its structure is being recited as dependent upon forces imposed by the bowling ball," showing the Examiner is assuming the structure of the recited finger pad shield means is recited as one of the operating parts of a complex machine with the bowler and the ball operating interactively as parts of the machine. However, Examiner has not has not provided any record based facts or reasons which might justify this assumption.

In summary, Examiner has left an incomplete record without all of the critical fact finding determinations based on any available facts in the disclosure or ny other record based fact about what one of ordinary skill in the art would know or how such a person would evaluate Appellants' claims in light of the disclosure, the teachings of the prior art, the knowledge of one of ordinary skill in the art or how such a skilled person would evaluate the claims.

2.

The standard for examining definiteness of claim language under 35 USC 112, 2<sup>nd</sup>

Paragraph

MPEP 2173.02 requires claim language not be analyzed in a vacuum but in light of, A.  
The content of the particular application disclosure.

B. The teachings of the prior art.

C. The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

Examiner has made no record fact analysis of Appellants disclosure, or the teachings of the prior art as to what one skilled in the art of bowling would know or how one so skilled would bowl, or how the claims would be interpreted by one of ordinary skill in the art of bowling. Examiner's arguments throughout Examiner's Office Action and Answer, are based on his assumption and statement that he is one skilled in the art (see Examiner's statements in 1., above), and he knows how the claims would be interpreted by one of ordinary skill in the art. Examiner has made these assumptions and statements, without record based fact support, and without rebutting the record based fact supported arguments of Appellants, as to what one of ordinary skill in the art would know or how one of ordinary skill in the art of bowling would interpret the claims, on the facts of the disclosure, the teachings of the cited Shaffer patent and the Declaration of R.A. Addington

3.

The claim elements, recited in structural language, using functional language or relative terminology, or means plus function language, analyzed in light of the content of the particular application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made, would be clear to one of ordinary skill in the art of bowling. Examiner is not one of ordinary skill in the art of bowling, and Examiner does not know how one of ordinary skill in the art of bowling would bowl

The claim elements are each recited in structural language, or in structural language using functional limitations or relative terminology such as "maximum," or in means plus function language, reciting "finger pad shield means," or "a means for protecting a bowler's finger pad," or as an additional function of an antecedent means, such as the first or second

surface of the finger pad shield means, (see claim 1), and are acceptable under the guidelines of the MPEP, Sections 2173.05(g) and 2181. Appellant states the ordinary meaning of all of the recited elements, including functional limitations, are written in compliance with 35 U.S.C. 112, 2<sup>nd</sup> Paragraph, are supported by the specification, in compliance with 35 U.S.C. 112, 1<sup>st</sup> Paragraph, and would be clear to the "hypothetical person possessing the ordinary level of skill in the art." See MPEP Section 2171.

That hypothetical person would know how one of ordinary skill in the art of bowling would bowl by would first removing the thumb, and with the thumb removed from the ball, using the middle two fingers to impart lift to the ball on its release, by pushing up on the ball using the middle finger.. See the cited Shaffer patent, col. 3, lines 35 - 65 and col. 4, lines 1-25, and the Declaration of R.A. Addington. Examiner has made no rebuttal to the facts of the cited Shaffer patent or of the Declaration of R.A. Addington, or states any facts from the Marinese patent teaching use of the thumb to "lift" the ball at its "release."

Instead of record based facts of what one of ordinary skill would know of the bowling art, Examiner has show only his understanding of bowling as requiring rotating the thumb, as described in Section III, above, which is contrary to the understanding one of ordinary skill in the art of bowling knows of bowling basics. Because of Examiner's understanding which is shown to be contrary to that of one of ordinary skill in the art of bowling, Examiner has demonstrated he could not be expected to find the recited means plus function claims clear. However, one of ordinary skill in bowling knowing that a bowler of ordinary skill first removes the thumb and then imparts lift from the use of the middle fingers at the release of the ball, as described in the Shaffer patent and in the Declaration of R.A. Addington, would understand the specification and the means plus function claims, which are based on the specification, based on that knowledge..

A functional limitation of an element, not within a means plus function claim, describing what an element does rather than what it is, must be evaluated for what it fairly conveys to one of ordinary skill in the pertinent art. MPEP 2173.05(g) This is a 112 2<sup>nd</sup> Paragraph issue and not a 112 6<sup>th</sup> Paragraph issue. Examiner, has shown by his statements, above, that he does

not have the basic knowledge of bowling to qualify as one of ordinary skill in the art and any presumption of that fact has been eliminated by the record based facts, (see III., above, and 1., above of this Section IV.), and that he has made no record based fact determination of what one of ordinary skill in the art would know about bowling or what any functional recitations as recited in the claims, would convey to one of ordinary skill in the art.

Based on the facts in the record as what is shown and described in the specification or what is known by one of ordinary skill in the art, claims to the bowling device of the finger pad shield means (claim 1), the means for protecting a bowlers finger pad, (claim 16), the finger pad shield )claim 19), and the finger pad shield means, (claim 31), would be clear and unambiguous.

3.

Examiner's irrelevant or scandalous statement should be stricken

Appellants object to Examiner's statements that,

Examiner cannot determine whether appellant is just being argumentative or if he is just not in a capacity to understand,

page 7, and

However, it is apparent that the applicant is confused by his own self developed 'APA Standard" the (sic) patent prosecution,

as scandalous and asks that The Board strike these remarks from the record.

Appellants object to Examiner's statement,

The situation must be clear for the purposes of infringement,

page 8,

because consideration of infringement is outside the scope of Examiner's inquiry, is irrelevant to the examination of the claims for patentability, and requests The Board strike this statement.

V.

Reply to Examiner's Answers, VIII; I,(Argument No. 1), sections C to G, Pages 9 -10.

Appellant stands on his statements made in his Brief, I. (Argument No. 1), sections C to G. and on the APA Standard of Substantial Evidence, as stated above.

1.

Section C., of Examiner's Answer, 1.(Argument No.1), pages 7-9, is directed to the rejection of claims 16 -17 as reciting a term that is an indefinite variable

Examiner's sole bases for rejection of claims 16 and 17 are his conclusions,

a) [Examiner] as "one skilled in the art, [he] does not have a clue what [these claims] mean."

b) . . .it is not clear what is a 'maximum natural force' and the 'limit o(sic) muscular skeletal development is different for all bowlers based on age, size, ability, and style of delivery.

c) Hence, under such variable conditions, there exists no way for one skilled in the art to determine 'definite boundaries.'

Apparatus claims may have elements recited in functional limitations (see MPEP 2173.05(g) which must be considered in the context of what it fairly conveys to one of ordinary skill in the art in the context it is used. Examiner has shown no record based facts one of ordinary skill in the art would not understand the meaning of claims 16-17 from the context of the specification. Instead Examiner has failed to show he is one of ordinary skill in the art, and Appellants have asserted in this record Examiner is not one of ordinary skill in the art. See Section III. and IV., 3, above. Whether or not Examiner is one of such ordinary skill, Examiner's record is limited to his conclusions, relying only on his understanding or experience, or on his assessment of what would be basic understanding or common sense, which are not supported by record based facts and these conclusions do not meet the APA Standard of substantial evidence and without substantial evidence, cannot be used to support any rejection of the claims. .

Examiner has provided no record based facts to support Examiner's dismissal or rebuttal of the Declaration of Dr. W. Robert Addington, DO, (see Appellants' Brief, I. Argument No. 1, section C, where Appellant relied in part on that Declaration traversing Examiner's grounds of rejection.) Examiner has made statement of record based facts in opposing the Dr. W. Robert Addington, DO, Declaration or the facts as stated therein. Without a rebuttal to the facts of that Declaration, Examiner's rejection of the claimed invention must be held to be incomplete. Examiner's sole statement, referring to the Declaration of Dr. Addington, DO, is, "the Examiner cannot agree since such amounts to a general allegation . . ." However, Examiner provides no record based facts to support his conclusion by concrete facts in the record, and Dr. W. Robert Addington's Declaration and its facts remained as un-rebutted in support of patentability.

Appellants and Examiner, however, do agree with the Examiner statement, "maximum natural force and the "limit of muscular skeletal development is different for all bowlers." Examiner argues that the "maximum" force is different for each bowler in the general population of bowlers and Appellants agree with this statement but only to and limited to the extent of that statement, as made herein. MPEP 2173(05)b does state claim language which includes terms of degree considered not precise, does not automatically render the claim indefinite. The test given by the MPEP for terms of degree is whether one of ordinary skill in the art would understand what is claimed in light of the specification.

The knowledge of one of ordinary skill in the art of bowling is as shown in the cited Shaffer patent and as disclosed in the Declaration of R.A. Addington. The specification describes the Objects of the Invention, as including a means to protect the bowler's finger when the bowler is applying the bowler's maximum natural force to the ball to lift the ball at the moment of the ball's release from the bowler's middle finger. Specification, page 4., lines 16-24; page 5, lines 1-9; and from page 23, line 14 to page 24, line 15 stating,

As will be apparent to those skilled in the art, any force  
generated by the weight or counter forces of the bowling ball  
against the bowler's finger will be transmitted from the finger pad



shield means 14, whether from that part of the finger pad shield means opposed to the bowler's finger pad 14 or the end 15 opposed to the tip of the bowler's finger, through the support means 12a, 12b to the load bearing means, 20a, 22a.

The finger pad shield 14, opposed to, in contact with the bowler's finger pad 16 places a rigid surface between the force of the bowling ball against the finger pad 16 and spreads that force, when the bowler's maximum natural force is applied to the bowling ball at the moment of release. It is at this moment, as explained above, when the bowler applies the maximum force to the finger hole of the ball and the force of the bowling ball against the finger pad shield 14 and the finger pad 16 is the greatest. It is as this moment of release that and the pressure within the contact area made by the finger pad shield 14 with the finger pad 16, is spread by the finger pad shield over the area of contact on the finger pad shield 14 and made with the finger pad 16. The finger pad shield 14 is made sufficiently rigid to substantially resist any flexing or deformation from that force of the bowling ball so that force against the finger pad shield 14 is spread over the contact area. The force which the rigid finger pad 14 resist is within a range limited by the conventional limit of bowling ball weights and the limit of muscular skeletal development. In the sport of bowling, a bowler will choose a ball suitable to that bowler's muscular skeletal development and within the range of weight allowed by bowling authorities such as the American Bowling Congress. While a stronger bowler at the upper limit of muscular skeletal development, may prefer a heavier ball, the force applied from the bowling ball to the finger pad 16 will be in a range limited by the maximum weight of a bowling ball and the maximum force which can be applied to the bowling ball within a range of muscular skeletal development. The finger pad shield

prevents that force produced between the bowling ball hole and the bowler's finger pad 16, from creating pressure spots on the finger tip or within the contact area made by the finger pad shield 14 with the bowler's finger pad 16, and reducing wear on, and fatigue of, the finger pad.

From appellants' specification, the Declaration of Dr. W.Robert Addington, DO, and the Declaration of R.A.Addington, (see Paragraph 3, therein), there is a definite limit to a range of human muscular skeletal development and within that limited range of human muscular skeletal development, there is a limit to the "maximum force" a bowler within that defined range of muscular development is capable of applying to the bowling ball at the release of the ball. Examiner's reliance on age or size, or ability or style, as particular limiting facts, has not been made relevant to Examiner's grounds of rejection because Examiner has not shown or demonstrated from record based facts, how the age, size, ability, or style, of any one bowler, affects or changes or alters or makes indefinite in any way, the definite limit to the "maximum force" a bowler within that defined range of muscular development is capable of applying to the bowling ball at the release of the ball. However, one of ordinary skill in the art, as shown by the cited specification, the Declarations of R.A. Addington and Dr. W.Robert Addington and the cited Shaffer patent, would understand the recitation of "maximum force," is within a range limited by a definite limit of muscular development, and would understand the recitation in the claims of a "maximum," as limited to a maximum in a defined range for the general population of bowlers. Examiner has made no showing of any record based facts in dispute of that defined maximum limited range.

Examiner has not provided a complete record of all of critical fact finding determinations and Examiner's rejection of claims 16-17 are defective.

Examiner's reliance on the "bicycle seat" example in MPEP 2173.05(b) is misplaced as lacking a defined range for an "unspecified build," is not consistent with Appellants' defined range of a maximum based on the limit of muscular skeletal development. A better citation supporting Appellants' claims is given in MPEP 2173.05(b) of the "wheel chair dimensioned

to fit into a range of openings of a car door with a definable upper limit.

2.

Appellants' Reply to Section F, of Examiner's Answer, 1.(Argument No.1), pages 9-11,  
directed to the rejection of claim 15

Appellants repeat their statement made above in this Section V., 1. above.

In Section F, of Examiner's Reply on Page 9, section F, Examiner states,  
...examiner has given the language it broadest reasonable  
interpretation.

However, in interpreting means plus function claims, the claims are to be interpreted as the functional elements which are the same or equivalent to the structure or material described in the specification. MPEP Section 2181, and interpreting a functional limitation, the limitation is to be considered for what it fairly conveys to a person of ordinary skill in the art, in the context in which it is used. MPEP 2172.05(g). Examiner's interpretation does not provide any record based facts in support of Examiner's interpretation, it does not rely on, or is not limited by, the record based facts of the specification and is beyond the limits of the MPEP interpretation and must be rejected.

Examiner has stated,

a) For the reasons stated in response to appellants arguments in section C,. (in Examiner's Answer), the language of Claim 15 also fails to set forth a definite standard where one skilled in the art can determine what material is rigid enough to be 'adapted to spread said force of said bowling ball over said contact area.'

b) Claim 15 is narrative.

c) How one makes something to "resist deformation" is vague and indefinite.

d) Claim 15 is not a means plus function claim.

Examiner has shown no record based facts in support of the above statements, serving as

Examiner's bases for rejection of Claim 15, including any definition of a "narrative" claim., or any basis in law for a "narrative" claim.

Appellants' specification on page 23 describes the finger shield pad as, made sufficiently rigid to resist deformation from the force of the bowling ball when the bowler's maximum force is applied to the bowling ball. The finger pad shield resists deformation so that force is spread over the contact area made between the finger pad shield and the bowler's finger pad. How one makes the finger pad shield to resist deformation to the force of the bowling ball is disclosed, with regard to the use of Aquaplast or other similar material. See specification page 12. In regard to the range of forces potentially causing deformation, and which the finger pad shield is made to resist, these forces have a defined maximum, are determinable, as stated above, and any one of ordinary skill in the art of bowling, with knowledge of the force produced by the ball at release, would know how to fashion a Aquaplast or other plastic material of sufficient rigidity to resist deformation.

While Examiner says, claim 15 is not a means plus function claim, Examiner has stated no record based facts to show a "means" is not recited or to show why the recitation of some structure in a means plus function claim should preclude applicability of 35 USC 112, 6<sup>th</sup> Paragraph, (see MPEP 2181), or why the recitation of claim 15 is "narrative" or not a function. (see MPEP 2181, for a "jet driving device," described as made "so constructed and located on the rotor as to drive the rotor," and acceptable under 112, 6<sup>th</sup> Paragraph.)

While Examiner states, "in short, merely stating what "something does" is not definite if no clear structure can be determined," MPEP2181 make it clear a "jet driving device" may be claimed with the scope of 112, 6<sup>th</sup> Paragraph, by what it does or how it is made. Examiner has shown no record based facts why Examiner's statement is supportable.

Examiner has not shown why claim 15 cannot be interpreted to cover the corresponding structure disclosed in the specification and equivalents. MPEP 2181. Examiner has failed to make state his rejection of claim 15 in a record supported statement of facts, as required by

the APA Standard of substantial evidence and Examiner's rejection should be reversed.

In section F, Page 10, Examiner's statement,

. . .it is apparent that the applicant (sic) is confused by his own self-developed 'APA Standard' the (sic) patent prosecution, is scandalous, prejudicial and it is requested The Board strike this statement. Section G is evidence of recited claim language similar to the language used by Appellants as evidence of acceptable Patent Office practice.

## VI.

### Reply to Examiner's Answers, VIII; I, (Argument No. 2), Page 11

Appellant stands on the Appellants' Brief. and on Appellants' Reply Sections V., Reply to Examiner's Answer, sections C and F, above.

Examiner has demonstrated by his *Summary*, Section III, and in Section IV., above, he does not have the knowledge of one of ordinary skill in the art of bowling, does not understand how one of ordinary skill in the art of bowling releases the ball by first removing the thumb and then using the middle two fingers to rotate the underside of the ball upward in an effect called lift, as these middle fingers leave the ball on release. See the Shaffer patent, col. 3, lines 46-55. As stated in Examiner's rejection, Examiner interpretation of the claim was not limited by the means plus function limits of 35 U.S.C. 112, 6<sup>th</sup> Paragraph, or to the structure disclosed in the specification and equivalents, or of the functional limitation under 35 USC 112, 2<sup>nd</sup> Paragraph, of what the claim would fairly convey to one of ordinary skill in the art in the context it is used.

By an impermissibly broad interpretation without providing any record based facts in support Examiner's interpretation of the means plus function claims and the corresponding structure, materials, or acts in the specification and equivalents, imposed by 6<sup>th</sup> Paragraph of 35 U.S.C. 112, (see MPEP 2181) or of what would be fairly conveyed to one of ordinary skill in the art by the functional limitations, in accordance with 35 USC 112, 2<sup>nd</sup> Paragraph (see MPEP

2171.05(g)), Examiner's conclusions, denying patentability without record facts in support or without rebutting issues raised by Appellants, must be reversed, or a new examination granted.

## VII.

### Reply to Examiner's Answers, VIII; I, (Argument No. 3), Pages 11-14

Examiner does not have the knowledge of one of ordinary skill in the art of bowling, does not understand how one of ordinary skill in the art of bowling releases the ball by first removing the thumb and then using the middle two fingers to rotate the underside of the ball upward in an effect called lift, as these middle fingers leave the ball on release. See Sections III., IV., and V., above.

To the extent of Examiner's rejection, Examiner interpretation of the claim was not limited by the means plus function limits of 35 U.S.C. 112, 6<sup>th</sup> Paragraph, or to the structure disclosed in the specification and equivalents, or of the functional limitation under 35 USC 112, 2<sup>nd</sup> Paragraph, of what the claim would fairly convey to one of ordinary skill in the art in the context it is used.

Examiner disagrees with Appellants that Claim 1 is recited as means plus function elements. Claim 1 is reproduced here for examination.

Claim 1. A bowler's finger pad shield for protecting a bowler's finger pad proximate an end of a bowler's finger from the force of a bowling ball against the finger pad of said bowler's finger, when a bowler's maximum force is applied by the finger pad to the bowling ball in the release of the bowling ball, comprising:

- a. a finger pad shield means having a first surface, and a second surface opposed to said first surface;
- b. said first surface including a contact area for receiving a finger pad of a

bowler's finger proximate an end of said bowler's finger;  
c. said second surface for insertion into a finger hole of a bowling ball against the interior wall of said finger hole and for receiving a force of said bowling ball when a bowler's maximum force is applied by said finger pad to the bowling ball, in releasing the bowling ball;  
d. means for placing, connected to said finger pad shield means, for placing said contact area in contact with said finger pad; and wherein  
e. said finger pad shield means is made of a rigid material adapted to spread said force of said bowling ball over said contact area of said first surface for reducing the pressure over said contact area.

(underlining added)

For purposes of 6<sup>th</sup> Paragraph, 35 U.S.C. 112, it is necessary to determine, on an element by element basis whether the 6<sup>th</sup> Paragraph applies. MPEP 2181. While elements a, d, and e, are expressly recited as a means plus function, elements c are recited as express functions within the finger pad shield means plus function element recited as element a, and are functions of recited means plus function element a.

Under 35 USC 112, 2<sup>nd</sup> Paragraph, a functional limitation is evaluated for what it fairly conveys to one of ordinary skill in the art in the context it is used. MPEP 2173.05(g).

The burden on Examiner is to show record based facts in support of Examiner's interpretation of the claimed elements and of Examiner's conclusion that the claimed elements are shown in the prior art. Instead of record based facts.

Examiner has made the following statement in rejecting Appellants' claims.

A) The functional statements of paragraph c. fail to distinguish over the art since the applied art is capable of performing the intended use of protecting the finger while bowling and spreading out the force applied by the finger to the bowling ball.

B) Applicant's continued reference to the function of his finger shield as spreading the force does nothing to distinguish over the art of 'finger protectors' in general. Supporting and

spreading the force to protect a finger is rudimentary to their purpose.

C) The mere intent of using his finger device on a bowling ball does not distinguish it over the art of record.

D) . . .the intended use of applicant's invention to pick up a bowling ball does not distinguish it from Fowble since the intended operation are (sic) of no significance in determining patentability of apparatus claim.

E) [Appellants'] position appears to be one of analogous art and that since Fowble is not disclosed as being used with a bowling ball, then it cannot meet the functional limitations.

F) Even when cloaked within means plus function language, nothing prevents the prior art from being used with a bowling ball.

G) Clearly the finger cot of Fowble performs the function 'to spread force' said contact area of said first surface for reducing the pressure over said contact area.

H) Such a protection from the forces encountered in performing a task is rudimentary to finger protection cots.

I) Fowble shows, 1) a finger pad having a pad shield means with a first curved surface and a second curved surface including a contact area, 2) the recitations in [claim 1,] paragraph c, are functional and fail to distinguish over Fowble, 3) the strap of Fowble is capable of serving as a limit means and is considered a raised surface, 4) the shield is made of rigid material.

Examiner's grounds for rejected of the claims as anticipated by Fowble are limited to a listing of Examiner's conclusions A) to I) above, without any record based fact in support.

Examiner has failed to demonstrate by a complete fact based record how Examiner in an element by element analysis, interpreted the rejected claims in accordance with 2<sup>nd</sup> and 6<sup>th</sup> Paragraphs of 35 USC 11, and how each of the elements as interpreted by Examiner, are taught in Fowble. All Examiner has done is rely on hindsight to say the device of Fowble could be used in bowling. Examiner then has offered some conclusions as general statements without limiting the generals statements to the claim elements asserted by Examiner as anticipated.

Examiner says " the recitations of paragraph c. are functional and fail to distinguish over



Fowble." However, Examiner must deal with each claim element and the words as used in its full recitation and show how the prior art meets each claim element limitation and Examiner's interpretation of the claim and its elements. If any words in the element's recitation are to be removed from consideration of the claimed element, for example as Examiner has done for the recitation of paragraph c. the respective reasons therefore must be provided. Otherwise, Examiner has not performed this element by element examination and his rejection is not support by record based facts. Under these circumstances, Examiner forces us to rely on his own knowledge, without a fact based record in support of his critical conclusions, as required under the APA Standard of substantial evidence. With a deficient record left by Examiner, the Appellants are left to guess at the record based facts or reasons of the rejections or the critical determinations made by the Examiner is formulating the rejections.

Examiner has not met the requirements of 35 USC 102 (see MPEP 2131), to show by a fact based record, the same structure for each element, on an element by element basis and show a prior art element performing the identical function, or where the element is recited as a means plus function, the prior art element's structure is the same or equivalent to the structure or material described in the specification.

Examiner has failed to respond to all of the issues raised by Appellants and Examiner's record of the core determinations made by Examiner is incomplete, leaving a presumption Examiner has based his conclusions on assumption, his own understanding or experience, or on what Examiner believes is basic knowledge or common sense and Examiner has failed to meet the examination standard of substantial evidence. Examiner has not responded with record based fact support to the arguments and issues raised by Appellants, such Appellant raised issues being about the way one of ordinary skill in the art would interpret the claims, or the location in Fowble where the structure asserted by Examiner may exist, or the use of hindsight by Examiner to see in Fowble what Examiner first learned from Appellants' disclosure or that Examiner has not rebutted the Declaration of R.A. Addington with record based facts.

Examiner's statement,

However, applicant chooses to ignore the MPEP and again offer clouded arguments pertaining to an APA Standard he has devised.

Is scandalous and prejudicial and The Board should strike this statement from the record..

Examiner's citations to case law are of facts different from the facts of Appellants' invention and cannot serve as legal precedent.

The rejection of Appellants' claims should be reversed or a new examination granted..

### VIII.

#### Reply to Examiner's Answers, VIII; I, (Argument No. 4), Page 14

Appellants stand on their statement made in their Brief. Examiner's citations to case law are of facts different from the facts of Appellants' invention and cannot serve as legal precedent. Examiner's statement of facts may be seen by inspection, as limited to a statement that Pratt shows combining finger inserts with gloves and to have included a glove in combination with the insert shown by Fowble would have been obvious. There are no showing of record supported facts to support Examiner's statement or any record supported facts of what the references teach or how the teachings of the references would make the combination of these teachings into the recited claims of Appellant or any record supported facts of the Examiner's claim interpretation or any record supported facts of Examiner's rebuttal of Appellant's arguments and issues. Examiner's rejection is an incomplete record limited to conclusions based on assumptions or what Examiner believes is common knowledge and fails the APA Standard of substantial evidence. The case law cited by Examiner is based on facts which are not the facts of Appellant's recited invention and are inapplicable. Examiner's rejection should be reversed or a new examination granted.

### IX.

#### Reply to Examiner's Answers, VIII; I, (Argument No. 5), Page 14

Appellants stand on their statement in V. (Argument No. 5) with the following statement.

While Examiner states,

Hence in view of the examiner's broadest reasonable interpretation of the language used in the claims . . .

Examiner has not provided an element by element interpretation of the claims supported by record based facts or in accordance with MPEP 2181 for means plus function claims and for claims with functional limitations, in accordance with MPEP 2173.05(g). It is impossible to know how Examiner interpreted the claims or how Examiner applied the *Marinese* reference. All we know is what Examiner said that he has made "the broadest reasonable interpretation." In the case of *Marinese*, Examiner has made no fact based record. What Examiner has done is simply reach conclusions based on his own understanding or experience or on Examiner's assessment of what would be basic knowledge or common sense. Rather, the Examiner must point to some concrete evidence in the record in support of Examiner's findings. That is the CAFC standard of substantial evidence imposed as an examination standard. It requires the Examiner make a complete record based on substantial evidence. All Examiner has done is state his unsupported conclusions in the barest possible terms.

This rejection in which claims are rejected as anticipated by *Marinese*, stands as an example of a deficient examination missing a record of how the Examiner interpreted each claim and the respective elements, how each element was anticipated by a corresponding element in the prior art, and the record based facts supporting Examiner's conclusions of anticipation for each claim element and or Examiner's conclusions of inherency.

Examiner's rejection based on *Marinese*, states,

- A) *Marinese* is inherently capable of from (sic) maximum force developed by a bowler as called for in claims 17, 18, and 20,
- B) *Marinese* is rigid, as called for in claim 21,
- C) Wall part 3 is considered to be a raised surface as called for in claim 28,
- D) As to claim 30, both shield and support can be made from polymer material.

All of the these above statements A) to D), are conclusions without record based facts in support, except for Examiner's reference to col 2, line 66 of Marinese and statement D, about the polymer material. However, Examiner has failed to show how the disclosure of Marinese in col 2, line 66, meets the claim recitation for claim 27 or the facts of the claim interpretation by Examiner. For the rejection based on the "polymer" material, (see statement D) above), the only record source of the fact is from Appellants' disclosure of Aquaplast as a suitable material for the finger pad shield means. Examiner has failed to show by record based facts, the source of statement D) or how it is applied to Examiner's rejections of the claims' recited elements.

Examiner's rejection fails to meet the APA standard of substantial evidence requiring Examiner provide a complete record of his facts, the sources in the record for the facts, the facts and reasons of the Examiner's claim interpretation, the reasoning and facts used in rejecting the claims, and Examiner's facts and reasons used by Examiner against Appellants' arguments. Within this examination standard of substantial evidence, Examiner must identify why Appellants' arguments or issues are ignored, dismissed or rebutted. The case law cited by Examiner is based on facts which are not the facts of Appellant's recited invention and are inapplicable. Examiner has failed to meet this standard. Examiner's rejection should be reversed.

X.

Reply to Examiner's Answers, VIII; I, (Argument No. 6), Page15

Appellants stand on their statement in VI. (Argument No. 6) of the Brief and on the following

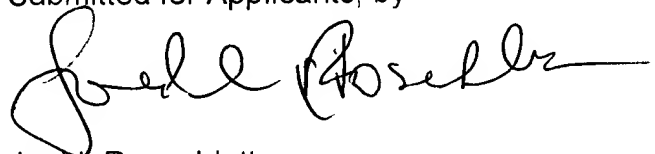
Claims 24-26 are recited as structure claims. Examiner must deal with each claim element and of the words as used in its full recitation and show how the prior art meets each claim element limitation. If any words in the element's recitation are to be removed from consideration of the claimed element, the respective reasons therefore must be provided. Examiner has failed to state any record based fact support for his claim interpretation, has stated conclusions without any record based fact support and has not rebutted Appellants'

arguments or issued raised by Appellants. Examiner has not performed that examination and Examiner's rejection is not support by facts as required under by the APA Standard of Substantial Evidence.

Examiner's statement of facts may be seen by inspection, as limited to a a statement that Pratt shows combining finger inserts with gloves and to have included a glove in combination with the insert shown by Marinese would have been obvious. The are no showing of record supported facts to support Examiner's statement or any record supported facts of what the references teach or how the teachings of the references would make the combination of these teachings into the recited claims of Appellant or any record supported facts of the Examiner's claim interpretation or any record supported facts of Examiner's rebuttal of Appellant's arguments and issues. Examiner's rejection is an incomplete record limited to conclusions based on assumptions or what Examiner believes is common knowledge and fails the APA Standard of substantial evidence.

Examiner's citations to case law are of facts different from the facts of Appellants' invention and cannot serve as legal precedent. Examiner's rejection should be reversed or a new examination granted with the term of any patent issuing extended from the date of the first office action.

Submitted for Applicants, by



Joel T. Rosenblatt

Attorney for the Inventors

Registration 26,025

445 11<sup>th</sup> Ave.

Indialantic, Florida 32903

321-727-7626; Fax: 727-8209

Email: [jrosenblatt@mindspring.com](mailto:jrosenblatt@mindspring.com)